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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/663,183	09/15/00	DEPUIS C	05725.0753-0

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EXAMINER
WELLS,L

ART UNIT	PAPER NUMBER
1619	7

DATE MAILED: 04/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/663,183	DEPUIS, CHRISTINE	
	Examiner	Art Unit	
	Lauren Q Wells	1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 January 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-102* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-102* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5* .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

DETAILED ACTION

Priority

It is noted that the foreign priority date is not perfected until an English translation of the priority document is provided.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-102 rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-3, 6, 9, and 23-32 of prior U.S. Patent No. 6,056,945. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-102 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33, 36-37, 47-59 of copending Application No. 09662804; over claims 1-76; 1-37, 78-112 of copending Application No.09662796; over claims 152-164 of copending Application No. 09663168; over claims 1-39, 42, 72-81, 83-85 of copending Application No. 09664402; and over claims 1-32; 51-60 of copending Application No. 0966~~4402.~~ 2805 Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed toward analogous hair compositions comprising silicone/acrylate copolymers, which comprise vinyllactam units, such as vinylpyrrolidone and vinylcaprolactam (Application No. 09664402 discloses vinylpyrrolidone copolymers as conditioning agents).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-102 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claims 3-27, 30, 35, 37, 46, 48, 52-76, 79, 84, 86, 95 and 97 are rejected for the use of improper Markush groups. See MPEP 2173.05(h) for examples of proper conventional or alternative Markush-type language, eg. ". . .selected from the group consisting of. . .and. . .".

(ii) The terms "derivatives" and "carbon based unsaturated compounds" in claims 1-103 are indefinite. The terms "derivative" and "carbon based unsaturated compounds" are neither disclosed in the specification nor would they be apparent to one of ordinary skill in the art. As a result, the metes and bounds of patent protection desired are unascertainable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-102 are rejected under 35 U.S.C. 103(a) as being unpatentable. over Blackenburg et al. (WO 99/04750) in view of Myers et al. (WO 94/12148).

Blackenburg et al. teach the use of polymers containing polysiloxanes for hair cosmetic formulations. A water-dispersible polymer is disclosed which comprises ethylenically unsaturated monomers and polyalkylene oxide containing silicone derivatives. The silicone derivative is disclosed as comprising 0.1-50% of the polymer, which meets the limitation of claims 28, 29, 77, and 78. Claimed formula (I) is disclosed, as are its R^1, R^2, R^3, and R^5 constituents, which meets claims 19-26 and 68-75. Silicone derivatives are disclosed as

dimethicone copolyols or silicone surfactants, which meets claim 27 and 76. Claimed formula (I_a) is also disclosed, as are its X, R^7, and R^6 constituents, which meets claims 3-17 and 52-66. Ethylenically unsaturated monomers further comprising silicone atoms, fluorine atoms, and thio groups are disclosed, which meets claims 18 and 67. Silicone/acrylate copolymers that are soluble in a proportion of greater than 0.1g/l, and preferably more than 0.2g/l in a water/ethanol mixture are disclosed, which meets claims 30, 31, and 79-80. The copolymers are disclosed for use in cosmetic hair formulations, such as hair sprays, which meets claim 49. Cosmetic additives disclosed include fragrances, preserving agents, vitamins, proteins, and others, which meets claim 48 and 97. A process of making the cosmetic product is disclosed. See entire disclosure.

Myers et al. teach aerosol hair spray formulations. The composition is disclosed as comprising vinyllactam units of the formula of instant claim 34. A vinyllactam unit with a phenyl group chosen from the copolymer of instant claim 35 is disclosed, which meets claims 35-36 and 83-85. Non-ionic polymers disclosed include N-vinyl-2-pyrrolidone and N-vinylpyrrolidone/vinyl acetate, which meets claims 37 and 86. The non-ionic polymers are disclosed as having a molecular weight of between 1000 and 100,000, which meets claims 38-40 and 87-89. 0.01-0.7% of the composition is disclosed as comprising the non-ionic polymers. Mediums disclosed include water/alcohol mixtures, which meets claims 2 and 51. Alcohols disclosed include ethanol, which meets claims 43-47 and 92-96. The reference discloses providing an aerosol hair spray formulation that has the consistency and firm texture necessary to hold hair in the desired arrangement for a certain length of time, which meets claim 50. A process of making the cosmetic product is disclosed. (See Page 1, lines 15-27; page 3, line 23-

page 4, line 41; page 7, line 9-page 8, line 31; page 9, lines 15-23; page 10, line 25-page 16, line 36.

It would have been obvious to one of ordinary skill in the hair fixative art at the time the invention was made to have modified the composition of Blackenburg et al. by adding the polyvinyl lactam of Myers et al. and obtain the claimed composition(s). The motivation to do so arises from the fact that (i) the cited analogous art discloses all claimed ingredients; and (ii) Myers et al. specifically teach polyvinyl lactams as conventional polymers in hair formulations, as cited above. Hence, both the motivation and reasonable expectation of achieving a hair formulation that provides body, consistency, firm texture, and maintains the hair in a desired arrangement are found in the prior art cited. Furthermore, the claimed process of fixing is inherent to the claimed fixative composition. Although the claimed ranges of the ingredients are found in the prior art cited, no criticality of these ranges have been established by the applicants.

Hence, the claimed subject matter fails to patentably distinguish over the state of the art as represented by the cited references. Therefore, the claims are properly rejected under 35 U.S.C. § 103(a).

No claims are allowed.

Prior Art

The prior art made of record and not specifically relied upon in any rejections cited above is either 1) considered cumulative to the prior art that was cited in a rejection or is 2) considered pertinent to the applicant's disclosure and shows the state of the art in its field but is not determined by the Examiner to read upon the invention currently being prosecuted in this application.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

Lauren Q. Wells
March 21, 2001

RAJ BAWA, Ph.D.
PRIMARY EXAMINER